

Appl. No. 10/619,736
Atty. Docket No. CM2503RQ
Amdt. dated June 30, 2006
Reply to Office Action of April 21, 2006
Customer No. 27752

REMARKS

Formal Matters

Claim 4 has been cancelled without prejudice. Claim 12 has been added. Claims 1, 8, and 9 have been amended.

Claim 1 has been amended to incorporate the limitations presented in originally submitted Claim 4. Claims 8 and 9 have been amended to overcome various rejections under 35 U.S.C. §112, ¶2. New Claim 12 has been added to claim the limitations originally presented in Claim 8 and removed by way of the instant Amendment. Applicants believe no new matter to have been presented in amended Claims 1, 8, and 9 and new Claim 12. Claims 1-3 and 5-12 remain in instant Application and are presented for the Examiner's reconsideration in light of the above amendments and the following comments.

Rejections Under 35 U.S.C. §112, ¶2

Turning now to the Examiner's rejection of the claims, Claims 8 and 9 were rejected under 35 U.S.C. §112, ¶2 for a plurality of reasons. First, the Examiner asserts that the word "plies" in Claim 8 lacks sufficient antecedent basis. By amendment herein, Applicants have amended Claim 8 to provide for the claimed method to further comprise the step of joining at least two plies of tissue paper web.

Claim 8 was also rejected for the presentation of a broad range or limitation presented together with a narrow range or limitation in the same claim. By amendment herein, Applicants have cancelled this subject matter referencing joining plies of the instant invention by embossing and presented the subject matter in new Claim 12. Applicants believe the instant rejections under 35 U.S.C. §112, ¶2 to Claim 8 have now been obviated.

Claim 9 has been rejected because the Examiner asserts that the word "sheets" lacks sufficient antecedent basis. By amendment herein, Applicants have amended Claim 9 to recite that the method further comprises the step of cutting the tissue paper product. Applicants now believe Claim 9 provides antecedent basis for all claim terms presented therein.

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With regard to the Examiner's rejection of Claim 9 under 35 U.S.C. §112, ¶2 as omitting essential steps, Applicants are at a loss to understand this rejection. The Examiner asserts that the omitted steps are required intermediate steps before the web is ready to be cut. Applicants are unaware of any law or regulation that requires these steps be included in the instant claim. Applicants claim only that the subject matter that the law requires and no more.

In light of the above amendments and for the reasons presented herein, Applicants respectfully believe the instant rejection to Claims 8 and 9 under 35 U.S.C. §112, ¶2 have been obviated. Applicants respectfully request the Examiner to withdraw these rejections.

Rejections Under 35 U.S.C. §102

Claims 1-7 and 9-11 have been rejected under 35 U.S.C. §102(b) over Wells, U.S. Patent No. 3,414,459. Applicants traverse this rejection for the following reasons:

1. Applicants' independent Claim 1 has been amended to require that the embossing elements have a height of less than about 0.5 mm.
2. Contrary to Applicants' process, the *Wells* reference does not require the embossing elements to have a height of less than about 0.5 mm. Specifically, the *Wells* reference requires the selected paper (i.e., the final product) to have discrete protuberances raised to a height of about 0.010 inch to about 0.040 inch, preferably about 0.020 inch, above the surface of the unembossed paper sheet. (4:53-57) That is, the paper produced by the *Wells* process has protuberances disposed upon it. The *Wells* reference provides no indication that any embossing elements that produce such protuberances have a height as required by Applicants' independent Claim 1.

Due to these considerations, the *Wells* reference fails to teach each and every element of Applicants' claimed invention. Therefore, Applicants respectfully request withdrawal of the Examiner's 35 U.S.C. §102(b) rejection with respect to Claim 1 and all claims dependent thereon.

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Rejections Under 35 U.S.C. §103

Claims 1-11 have been rejected under 35 U.S.C. §103(a) over Jennings, et al., World Publication No. WO 98/58124 in view of Roussel, et al., World Publication No. WO 99/45205 or Kamps, et al., U.S. Patent No. 5,702,571. The Examiner is respectfully urged to consider the following matters that distinguish Applicants' claimed invention over the combination of the *Jennings* in view of *Roussel* or *Kamps* references.

1. As mentioned *supra*, Applicants' Claim 1 now requires the embossing nip to have embossing elements with a height of less than about 0.5 mm.

2. The *Jennings*, *Roussel*, and *Kamps* references, alone or in combination, do not teach any process of using an embossing nip having embossing elements with a height of less than about 0.5 mm.

A proper analysis under 35 U.S.C. §103(a) requires, *inter alia*, the consideration of two factors: "(1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." See *Velandier v. Garner*, 348 F.3d 1359, 68 U.S.P.Q.2d 1769 (Fed. Cir. 2003), citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). In other words, "when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." See *Akamai Technologies, Inc. v. Cable & Wireless Internet Svcs., Inc.*, 344 F.3d 1186, 68 U.S.P.Q.2d 1186 (Fed. Cir. 2003). The cited references provide no such teaching, suggestion, or motivation.

In light of the above, Applicants request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Applicants' Claim 1 and all claims dependent thereon.

Conclusion

Based on all the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512. If any additional charges are due, the Examiner is authorized to deduct

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such charges from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

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